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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,415	07/06/2001	Grover M. Blackwell	2111.001	4993

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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/900,415

Applicant(s)

BLACKWELL ET AL.

Examiner

Yvonne M. Horton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,4,6,8,10 and 12 is/are allowed.
- 6) ☒ Claim(s) 1,3,13,15,18 and 19 is/are rejected.
- 7) ☐ Claim(s) 5,7,9,11,16,17 and 20-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3,13,15,18 and 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,978,614 to GOLDHABER in view of US Patent # 5,098,790 to DIEMUNSCH et al. In reference to claims 1 and 13, GOLDHABER discloses the use of a window covering (10), column 4, line s 20-23, including a core material (22,222) and a stile (24,220) having a first side (32) generally parallel to a second side (34); wherein the first (32) and second (34) sides, contact the respective sides of the core material (22,222). The stile (24,220) also has at least one hinge (207) attached thereto. GOLDHABER discloses the basic claimed device except for including a first and second plane of material positioned on either side of the core.

DIEMUNSCH et al. teaches that it is known in the art to form a panel from a first plane of material (1) and a second plane of material (3) having a core (2) disposed there between; wherein the core material is a polycarbonate. DIEMUNSCH et al. does not detail how his panel is intended to be employed; however, clearly

DIEMUNSCH et al. satisfies all of the structural requirements for the panel limitations.

The applicant is again reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cover of GOLDHABER with the multi-layered panel of DIEMUNSCH et al. in order to create a cover that is durable, light weight, and that is also UV absorbent. In reference to claim 3, the stile (24,220) is linear. In reference to claim 15, the first plane of material (1) and the second plane of material (3) of DIEMUNSCH et al. each contact the center core (2). Regarding claim 18 and 19, inherently either the first plane (1) or the second plane (3) of material of GOLDHABER, as modified by DIEMUNSCH et al., are capable of being the exterior of the window covering (10). DIEMUNSCH et al. is merely concerned with UV protection, hence both the first (1) and second (3) planes of material are virtually the same. Hence, the position of the panel of DIEMUNSCH et al. is not a critical aspect of the panel of DIEMUNSCH et al. Therefore, the positioning thereof would be a matter of obvious design choice.

***Allowable Subject Matter***

Claims 7,9,11,16 and 17 remain as being objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 5,20 and 21 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2,4,6,8,10 and 12 remain as being allowed.

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Claims 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 04/06/04 have been fully considered but they are not persuasive. In regards to the applicant's argument that GOLDHABER does not teach a sandwiched material that is formed from two or more planes of material, the examiner agrees. However, GOLDHABER was provided as a base reference under USC 103 to teach a window covering having a stile to hold a single-plane polycarbonate material and at least a hinge. GOLDHABER was modified by DIEMUNSCH et al. to teach the use of a multiple plane material. In essence, GOLDHABER does not teach a multiple-pane material. However, the combination of GOLDHABER as modified by DIEMUNSCH et al. teaches the claimed window covering.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding the applicant's argument that there is no teaching that DIEMUNSCH et al. is used to form a window covering or shutter, DIEMUNSCH et al. was provided to show that a polycarbonate similar to the single-plane material of GOLDHABER can be formed from multiple-planes of material.

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In response to applicant's argument that the panel of DIEMUNSCH et al. is not "used" as a window covering or shutter, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a shutter or the covering providing protection against missiles or projectiles) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the applicant's argument that DIEMUNSCH et al. does not teach a multiple layer window covering, GOLDHABER is the main reference that teaches all of the basic requirements of a window covering in general and DIEMUNSCH et al. was provided to teach the use of a multiple-plane polycarbonate material. DIEMUNSCH et al. does not detail how his panel is intended to be employed; however, clearly DIEMUNSCH et al. satisfies all of the structural requirements for the panel limitations. The applicant is again reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention

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and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, although GOLDHABER does not teach a multiple-plane material, DIEMUNSCH et al. was provided to teach that it is known in the art to form a similar polycarbonate panel having multiple-planes of material.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703) 308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
YMH  
June 21, 2004

  
Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600